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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,206	07/24/2001	Jason Gauci	2754	8122

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT PAPER NUMBER

3632

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,206

Applicant(s)

GAUCI, JASON

Examiner

Naschica S Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/23/01 & 12/28/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is the second Office Action for serial number 09/912,206, Outdoor Light Mounting Bracket, filed on July 24, 2001. Claims 1-10 have been cancelled. Claims 11-14 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/02 has been entered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference signs not mentioned in the description: *numeral 53*. It appears Applicant proposed modifications to page 5, line 16 in the marked up copy of the specification (see page 1 of Amendment filed 12/28/01); however these changes were not incorporated into the specification because a clean copy of the paragraph was not provided.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "46" has been used to designate both the fastener (Fig. 2)

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and projection (Fig. 1). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 11 is objected to because of the following informalities: on lines 6 and 7, -- upper and lower-- should be inserted before "projections" and "apertures" for consistency. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said support" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent 4,222,093 to Garcia et al. (Garcia). With regards to claims 11-14, Garcia discloses a wall mountable light fixture assembly (as viewed when Fig. 3 is rotated 90° clockwise) comprising: a first planar support section (18) including one upper projection (50) having a threaded portion (52) coacting with a threaded element (54) and one upwardly angled lower projection (48) positioned to align with the upper (defined between 44) and lower (40) apertures of a planar section (38) of a second support (16) that is adapted to be secured to a vertical support surface, whereby the lower projection is first insertable through the lower aperture to permit resting of the light fixture thereon and to be upwardly rotated so that the upper projection is inserted into the upper aperture to secure the light fixture (20) to the second support (16) and to cause the planar sections (18, 38) to abut. Regarding claim 11, Garcia does not teach the first and second supports including a pair of opposingly located and linearly spaced apart lower apertures and projections, respectively. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the light fixture by providing an additional projection on the first support (18) and an additional corresponding aperture (40) on the second support (16) since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Additionally, Garcia does not teach the first support including the apertures and the second support including the projections. It would have been obvious

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to one of ordinary skill in the art at the time the invention was made to have modified the first support to include the aperture and the second support to include the projections, since it has been held that the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Regarding claim 12, although Garcia does not disclose the lower aperture being a notch, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first section by substituting notches for holes since apertures, recesses, and notches are well known for their use in the fastening art and the selection of any of these known equivalents to secure the projection to the first section would be within the level of ordinary skill in the art.

Response to Arguments

Applicant's arguments filed 10/25/02 have been fully considered but they are not persuasive.

In response to applicant's argument that "...concerns a wall mountable outdoor light fixture" and "...requires that the device be a wall mount type of apparatus", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable* of performing the intended use, then it meets the claim. In a claim drawn to a process of

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making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Additionally, the embodiment of Figs. 1-5, while described by Garcia as a "ceiling mount", is considered to be a "wall mount apparatus" since a "ceiling" is a wall.

Regarding applicant's argument that "there are no upper and lower projections", examiner respectfully disagrees. The upper and lower projections have been more clearly detailed as set forth in the rejection above.

Regarding applicant's argument that Garcia could not be modified to use two projections because of the circular housing and that it would be inoperable, examiner respectfully disagrees. If Garcia were modified to include two projections, the two projections would be spaced apart along a straight line since the projections (48) are located at the edge of the rectangular first support section (18). Although the second support (16) is circular, the projections (and apertures) would still be linearly spaced apart at equal distances on opposite sides on a diametrical line extending between opposing edges of the circle (i.e. a diametrical line extending from 42 to 40).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: 6,439,750 to Klaus et al. discloses a wall mountable light fixture.


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703)

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305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine telephone number for the Technology Center is (703) 872-9326 (formal amendments) or (703) 872-9327 (After Final amendments).

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 872-9325.


Naschica S. Morrison
Patent Examiner
Art Unit 3632
12/2/02


KIMBERLY WOOD
PRIMARY EXAMINER